



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Paul Christou et al.
Serial No. : 09/980,650
Filing Date : April 5, 2002
Examiner : A. Kubelik, Ph.D.
Group Art Unit : 1638
Entitled : PESTICIDAL FUSIONS

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7-9-03
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Kimberly St. Clair Kelley

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**TRAVERSAL AND REQUEST FOR
RECONSIDERATION OF REQUIREMENT FOR RESTRICTION**

Dear Sir:

Applicants, through their undersigned attorneys, hereby traverse and request reconsideration of the requirement for restriction set forth in the Official Action dated May 30, 2003

in the above-identified patent application. A shortened statutory response period of one (1) month was set in the May 30, 2003 Official Action. This Traversal and Request for Reconsideration of Requirement for Restriction is being filed within the aforementioned response period.

As a preliminary matter, it is noted that a Preliminary Amendment which, *inter alia*, added new claims 42-49, was filed October 26, 2001 in this application, but was not taken into account in the requirement for restriction. Based on the dependencies of new claims 42-49, it appears that claims 42-47 should be included with Group I and claims 48 and 49 should be included with Group III.

The restriction requirement in this case is plainly improper for failure to comply with the relevant provisions of the Manual of Patent Examining Procedure (M.P.E.P.) pertaining to unity of invention determinations.

The present application was filed under 35 U.S.C. §371 as a U.S. national stage application under the Patent Cooperation Treaty.

As stated in 1893.03(d) of the M.P.E.P.:

Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications...

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a

single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.... Note also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions as amended 01 July 1992 contained in Appendix AI of the M.P.E.P.

Example 17 of Annex B Part 2 of the above cited Administrative Instructions reads as follows:

....Example 17

Claim 1: Protein X.

Claim 2: DNA sequence encoding protein X.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

Thus, a protein and the DNA sequence encoding it exhibit "corresponding special technical features" and, therefore, satisfy the PCT's unity of inventive requirement.

Accordingly, in the present case, claims 1-32 and 41-47, on the one hand, and claims 33-37 on the other hand, cannot properly be characterized as lacking unity of invention. It is

noteworthy in this regard that there was no lack of unity objection during the international stage of this application. Rather, the subject matter of all of the original claims was considered to be a single inventive concept.

The Examiner's citation of U.S. Patent 5,668,255 to Murphy does not warrant a different determination with respect to patentable distinctness in the present application. Applicants' claim 1 recites that the fusion must include a toxin and a domain having certain membrane binding properties, whereas the Murphy patent appears to disclose that the toxin is the domain having the membrane binding properties (see e.g. claims 1, 3, 17 of U.S. Patent No. 5,668,255).

As the restriction requirement set forth in the May 30, 2003 Official Action fails to comply with established United States Patent and Trademark Office practice, it is respectfully submitted that this requirement should be reconsidered and withdrawn at least insofar as Groups I, II and IV are concerned.

In order to be fully responsive to the above-mentioned requirements, applicants hereby elect the subject matter of Group I, i.e. claims 1-32 for examination in this application. This election is with traverse, for the reasons set forth above.

Applicants' election in response to the present restriction requirement is without prejudice to their right to file one or more continuing applications, as provided in 35 U.S.C. §121, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action on the merits of this application is respectfully requested.

Respectfully submitted,

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